



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,251	11/19/2001	Mitsuru Nakajima	1506.1014	8391
21171	7590	12/14/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			GODDARD, BRIAN D	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/988,251

Applicant(s)

NAKAJIMA ET AL.

Examiner

Brian Goddard

Art Unit

2161

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


SAFET METJAHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments are not persuasive. Referring to applicants' remarks on pages 10 and 11, applicants argued that Fleming III (and therefore the combination) fails to teach or suggest any outputting unit and, more specifically, an outputting unit that outputs the personal information of each user who searches for a piece of search target information, when that piece of search target information is specified.

The examiner disagrees for the following reasons: First, Fleming III clearly teaches an outputting unit by the display 124 and other input/output devices 157. These output units are configured for displaying the data shown in Figures 9 & 10, else Fleming III's invention would be completely useless. Note that the entire purpose of Fleming III is to output the usage information. Second, regarding applicants' argument that Fleming III lacks an outputting unit that outputs the personal information of each user...as claimed, applicants reasoning is based on spurious portions of Fleming's disclosure and fail to consider the reference as a whole. Applicants appear to be focused on the bottom portion of Figure 10, rather than the more pertinent top portion. Specifically, Fleming III teaches the output [See Figs. 9 & 10], when a piece of search target information [1010] is specified [See Fig. 10], of the personal information [1030 & Fig. 9] on each user [See 1030] by whom the piece of search target information is searched [See 1020] based on the pieces of information stored in the information storage unit. Applicants' reasoning is based on Fleming III's teaching of demographic estimates based on selected representative users (i.e. the bottom portion of Fig. 10). However, this functionality is taught IN ADDITION TO the claimed functionality. Fleming III goes above and beyond applicants' claimed invention, but this does not in any way teach away from the claimed invention as applicants contend. Applicants are directed to Fig. 9, the top portion of Fig. 10, and Column 12, lines 56-63 of Fleming III. Note that information on USER 4 is displayed in the top portion of Fig. 10, even though USER 4 is NOT a member of the selected sample group. Applicants' rationale bears no weight under this disclosure by Fleming III. The combination of Coden and Fleming III teaches each and every limitation of applicants' claimed invention, and the Section 103 rejection stands as Final.